

### REMARKS

This Amendment is made in response to the final Office Action dated December 16, 2008. Claims 1-9, 18 and 24-36, 37-39 and 44 were pending in this application. By this Amendment, claims 1-9, 18, 24, 25, 31, 37-39 and 44 have been canceled without prejudice. Claim 26 has been amended to more clearly define the presently claimed invention. Claims 27, 28 and 32 have been amended in view of the amendment to claim 26. New claims 47-65 are being presented for consideration. Favorable reconsideration of the pending claims is respectfully requested in view of the remarks below.

#### **Claims Rejected under 35 U.S.C. § 112, First Paragraph**

Claims 1, 3, 4, 8, 9, 18, 24-34, 38, 39 and 44 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description. The Examiner claims that there is insufficient basis for the recitation of a continuous direct bond joining the layer of polyimide to the layer of nylon. Applicants do not agree with the Examiner's position but have deleted this claim language in the presently pending claims to expedite allowance of this case. Applicants reserve the right to pursue the previously pending claims, and similar claims, in a continuation to be filed in the future.

#### **Claims Rejected under 35 U.S.C. § 103 (a)**

Claims 1, 8, 9, 18, 25-32 and 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 5,792,144 to Fischell (the "Fischell patent") in view of U.S. Patent No. 6,019,778 to Wilson (the "Wilson patent") and further in view of U.S. Patent No. 6,254,609 to Vrba (the "Vrba patent"). Claims 3, 4, 24, 33, 34, 38 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Fischell patent in view of the Wilson patent and the Vrba patent and in further view of U.S. Patent No. 6,736,839 to Cummings (the "Cummings patent").

Applicants note that independent claim 26 has been amended to more clearly define the presently claimed invention. Claim 26 and its dependent claims now include

the recitation of an outer catheter member having multiple portions that include a distal portion having a proximal end and a distal end, the distal portion being adapted to at least partially cover the medical device and having an inner surface which directly contacts the medical device. The outer catheter further includes an intermediate portion having a distal end and a proximal end, the distal end of the intermediate portion coupled to the proximal end of the distal portion, along with a proximal outer member having a proximal end and a distal end. The proximal end of the proximal outer member is attached to the control handle and the distal end of the proximal outer portion is coupled to the proximal end of the intermediate portion. This outer catheter is arranged with the inner catheter member such that the proximal end of the guide wire receiving member is received in an opening formed at the proximal end of the intermediate portion of the outer catheter member.

The Examiner has taken the position that the intermediate portion in the Fischell patent is the flexible tube 34 which has a proximal end attached to the distal end of a proximal portion, which the Examiner has identified as the flexible tube 32. The joint connecting these two tubes 32 and 34 is shown in Figure 1 where arrow 30 is located. As noted above, claim 26 and its dependent claims requires that the proximal end of the guide wire receiving member is received in an opening formed at the proximal end of the intermediate portion of the outer catheter member. Figure 1 of the Fischell patent clearly shows that there is no opening at the proximal end of this tube 34 to receive the proximal end of the guide wire receiving member. The proximal end of the guide wire receiving member in the Fischell patent terminates well distal to the proximal end of the tube 34, as is shown in Figures 1 and 7. Therefore, for at least this reason alone, the Fischell patent fails to disclose the structure of the amended claims. Additionally, claim 26 requires the distal portion of the outer catheter member to have an inner surface which directly contacts the medical device. Figures 6 and 7 of the Fischell patent, relied upon by the Examiner in rejecting the previously pending claims, show that there is a gap between the

distal tube 36 and the mounted stent 40. This is due to the placement of the tube 36 on the outer surface of tube 34 which raises the tube 36 away from contact with the stent 40. Again, the Fischell patent fails to disclose the complete structure recited in the pending claims.

The Wilson, Vrba and Cumming patents fail to disclose the particular structure recited in the pending claims as well. The Examiner has cited the Wilson patent based on its teachings relating to the use of nylon in a catheter. The Wilson patent, however, fails to disclose a rapid exchange type catheter and thus fails to address the shortcomings of the Fischell patent. The Vrba patent likewise fails to disclose the structure lacking in the Fischell patent. The Cummings patent lacks the recited structure and thus fails to overcome the shortcomings of the combination of the Fischell, Wilson and Vrba patents. Simply put, the combination of any of these patents fails to achieve the basic structure now recited in the amended claims. Accordingly, Applicants respectfully request the Examiner to withdraw the obviousness rejections against these claims.

Applicants submit new claims 47-65 which are directed to catheter assemblies which are not shown in the cited art. None of the cited art discloses a passage created in the outer catheter member as is recited in these claims. Favorable consideration of these claims is respectfully requested.

In view of the foregoing, it is respectively urged that all of the present claims of the application are patentable and in a condition for allowance. The undersigned attorney can be reached at (310) 824-5555 to facilitate prosecution of this application, if necessary.

In light of the above amendments and remarks, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Please charge any additional fee or credit any overpayment to our Deposit  
Account No. 06-2425.

Respectfully submitted,  
FULWIDER PATTON LLP

/Thomas H. Majcher/  
Thomas H. Majcher, Reg. No. 31,119

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